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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,831	10/11/2001	Kamal Acharya	NETS0085	3000
22862	7590	03/17/2009		
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			EXAMINER DUNHAM, JASON B	
			ART UNIT 3625	PAPER NUMBER
			MAIL DATE 03/17/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/975,831	<b>Applicant(s)</b> ACHARYA ET AL.	
	<b>Examiner</b> JASON B. DUNHAM	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 7-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3, and 7-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant canceled claim 6 and amended claims 1, 7-13, 22-23, and 25 in the response filed December 19, 2008 in reply to the office action dated September 11, 2008. Applicant's amendments to the last two limitations of independent claims 1 and 22 now positively recite the performed steps and render the previous conditional rejection moot. The examiner notes that in the interest of expediting prosecution the last two limitations were treated as positively recited steps in the September 11, 2008 action. Applicant's amendments to independent claim 23 render the previous 35 USC 112, second paragraph rejection moot, however independent claim 23 is now directed towards non-statutory "modules" necessitating the 35 USC 101 rejection noted below.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Referring to claims 1, 3, and 7-21. Claims 1, 3, and 7-21 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In re Bilski et al, 88 USPQ 2d 1385 CAFC (2008); Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim should positively recite the other statutory class (the thing or product) to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Here, applicant's method steps fail the first prong of the new Federal Circuit decision since they are not tied to a machine and can be performed without the use of a particular machine. Thus, the claims are non-statutory since they may be performed within the human mind.

The mere recitation of the machine in the preamble with an absence of a machine in the body of the claim fails to make the claim statutory under 35 USC 101.

Note the Board of Patent Appeals Informative Opinion Ex parte Langemyer et al-

[http://iplaw.bna.com/iplw/5000/split\\_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=](http://iplaw.bna.com/iplw/5000/split_display.adp?fedfid=10988734&vname=ippqcases2&wsn=500826000&searchid=6198805&doctypeid=1&type=court&mode=doc&split=0&scm=5000&pg=0)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1, 3, and 7-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pricescan (PTO-892, Ref. U) in view of McGlinn (US 2002/0152134) and further in view of Biswas (US 6,594,666).**

Referring to claim 1. Pricescan discloses a method for providing an integrated electronic list of providers, comprising:

determining at least one online provider for an item (Pricescan: page 4);  
determining at least one offline provider for an item (Pricescan: page 4);  
wherein the determining steps follow a request for a product (Pricescan: page 10);  
integrating the at least one online provider with the at least one offline provider to provide an integrated list of providers for the item (Pricescan: page 4);

Pricescan does not explicitly disclose distinguishing online from offline providers in a list and providing comparison information. McGlinn discloses:

- Distinguishing online providers from offline providers in said integrated list (McGlinn: abstract) and providing comparison information for the at least one online provider and the at least one offline provider for the item (McGlinn: figure 9 disclosing offline providers as “real storefront certified”)

It would have been obvious to one of ordinary skill in the art at the time of

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applicant's invention to have modified the method of Pricescan to have included distinguishing online from offline providers, as taught by McGlinn, in order to increase consumer trust (McGlinn: abstract).

The combination of Pricescan and McGlinn discloses searching by physical location (McGlinn: paragraph 23) but does not explicitly disclose a user choosing a target location or radius. Biswas discloses:

responsive to a determination of when the request is for a desired geographical area, a user may choose one of several target locations, which have been previously created and stored (Biswas: abstract and column 5, lines 25-30);

responsive to a determination of when the request is for a predetermined proximity to a target location, the user may choose a radius for said target location (Biswas: abstract and column 5, lines 25-30).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the method of Pricescan and McGlinn to have included requests for geographical areas wherein a user may choose a target location and requests for a proximity to a target location wherein a user may choose a radius to said target, as taught by Biswas, in order to allow the user to receive comparison shopping within a geographic area of interest.

Referring to claim 3. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the request is for a product category (Pricescan: Page 3).

Referring to claims 7-13. The combination of Pricescan, McGlinn and Biswas further discloses methods wherein the comparison information includes price, rating,

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review, availability, promotion, electronic wallet, and return-policy comparison (Pricescan: pages 3-12).

Referring to claim 14. The combination of Pricescan, McGlinn and Biswas further discloses a method providing comparison information about at least two offline providers (Pricescan: page 4).

Referring to claims 15-16. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes in-store return and pick-up policies of online purchase (Pricescan: page 4).

Referring to claims 17-18. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes special promotions and coupon availability information (Pricescan: page 4).

Referring to claims 19-20. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes proximity and direction to the at least two offline providers (Biswas: column 5, lines 25-30).

Referring to claim 21. The combination of Pricescan, McGlinn and Biswas further discloses a method wherein the comparison information includes user review (Pricescan: page 12).

Referring to claims 22-23. Medium and system claims 22-23 are rejected under the same rationale set forth above in the rejection of method claim 1 containing similar limitations.

Referring to claim 24. The combination of Pricescan, McGlinn and Biswas further discloses a system implemented on a network environment (Pricescan: pages 3-12).

Referring to claim 25. The combination of Pricescan, McGlinn and Biswas further discloses a system wherein the network environment comprises a global communications network (Pricescan: pages 3-12).

### ***Response to Arguments***

Applicant's arguments filed December 19, 2008 have been fully considered but they are not persuasive. Applicant argues that the combination of Pricescan, McGlinn, and Biswas does not disclose comparison of online and offline merchants as recited in independent claim 1. The examiner disagrees as figure 9 of McGlinn discloses comparing offline to online merchants by denoting those that are real storefront certified. Independent claims 22 and 23 and the respective dependent claims of claims 1, 22, and 23 are rejected under the same rationale.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason Dunham/ 3/13/09